PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of	Docket No: Q106386
Pascal CHARROPPIN	
Appln. No.: 10/767,143	Group Art Unit: 3628
Confirmation No.: 4295	Examiner: Shannon S. SALIARD
Filed: January 29, 2004	

For: DEVICE ALERTING TO EXPIRATION IN A FRANKING SYSTEM

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated March 4, 2011. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-10 are all the claims pending in the application.

Claims 11 and 12 have been canceled.

Claims 1-10 stand rejected and are the subject of this Appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Independent claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum et al. (US 7,103,583; hereinafter "Baum") in view of Boothby (US 5,684,990) and Dlugos et al. (US 6,463,133; hereinafter "Dlugos"), and further in view of Official Notice.

2. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby, Dlugos, and Official Notice, and further in view of Eckert (US 4,516,014).

3. Claims 1-3, 6, 7, 9, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby and Dlugos.

4. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby and Dlugos and further in view of Thiel (US 6,321,214).

Under section 6 ("Grounds of Rejection to be Reviewed on Appeal") of the of the Examiner's Answer, beginning on page 2, the Examiner states that "[every] ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading 'WITHDRAWN REJECTIONS.' New grounds of rejection (if any) are provided under the subheading 'NEW GROUNDS OF REJECTION.'"

The Examiner does not list any section with a subheading "WITHDRAWN REJECTIONS," and therefore, on its face, it appears the Examiner maintains each and every rejection listed above.

However, under section 9 ("Grounds of Rejection") of the Examiner's Answer, beginning on page 8, the rejections listed as items 3 and 4 above are not addressed. Accordingly, it appears

these rejections may have been withdrawn in view of NEW GROUNDS OF REJECTION, which are listed below.

New Grounds of Rejection:

5. Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby, Dlugos and Markl (US 5,710,706).

6. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby, Dlugos and Markl and further in view of Thiel.

In addition, on page 8 of the Examiner's Answer, the Examiner sets forth a new rejection not previously cited in any Office Action or modified in any Advisory Action, but not listed under the subheading "NEW GROUNDS OF REJECTION." This rejection is listed below.

7. Claims 5-7 and 9-10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby and Dlugos, and further in view of Official Notice.

In particular, claims 6, 7, 9 and 10 were not previously rejected in view of this combination of cited art, and therefore should have been listed under NEW GROUNDS OF REJECTION.

ARGUMENT

1. Independent claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum et al. (US 7,103,583; hereinafter "Baum") in view of Boothby (US 5,684,990) and Dlugos et al. (US 6,463,133; hereinafter "Dlugos"), and further in view of Official Notice.

Applicant submits that this rejection is improper for reasons previously presented in the Appeal Brief filed on December 8, 2010. Withdrawal of this rejection is respectfully requested.

The present invention allows the user to decide whether to use a new (updated) tariff or to use the current tariff even though it is out of date.

Specifically, independent claim 5 recites, *inter alia*, "when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date."

The Examiner takes Official Notice that it is known to continue to operate a franking machine with current postal data when it is determined that the postal data has not changed (Final Office Action dated April 28, 2010, page 13).

In the Advisory Action dated November 8, 2010, the Examiner cited Markl (U.S. 5,710,706) as support for the Officially Noticed position, specifically pointing to column 1, lines 20-33 (see page 2 of Advisory Action). However, this disclosure of Markl describes that a new rate table cannot be installed prior to the effective date of the rates in the new table, which causes a risk that out-of-date postal information may be installed in the postal scale unless the new table can be installed on the effective date of the new table.

Thus, if Markl discloses the use of an out of date rate table, it is only a result of a lack of a new table being installed and is described as a "risk," i.e., this is not desirable. Thus, it would not have been obvious to have modified Baum, Boothby, and Dlugos based on the fact that it is known that an out of date table of rates may be undesirably applied only if a new rate table has not been installed as of the effective date of the new table. The combination of Baum, Boothby, and Dlugos includes a new rate that has been installed, and therefore, the out of date table would not continue to be used even after the effective date of the new table.

Accordingly, the combined teachings of Baum, Boothby, Dlugos, and Markl would not allow the user to decide whether to apply an old tariff or a new tariff when the old tariff is out of date.

Thus, it is respectfully submitted that the combination of claim 5 is patentable over the cited art at least because none of the cited art disclose or suggest "when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date." Accordingly, Applicant submits that the rejection of claim 1 is in error for failure to establish a *prima facie* case of unpatentability, and should be reversed.

2. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby, Dlugos, and Official Notice, and further in view of Eckert (US 4,516,014).

Applicant submits that this rejection is improper for reasons previously presented in the Appeal Brief filed on December 8, 2010. Withdrawal of this rejection is respectfully requested.

3. Claims 1-3, 6, 7, 9, and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby and Dlugos.

Applicant submits that this rejection is improper for reasons previously presented in the Appeal Brief filed on December 8, 2010. Withdrawal of this rejection is respectfully requested.

4. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby and Dlugos and further in view of Thiel (US 6,321,214).

Applicant submits that this rejection is improper for reasons previously presented in the Appeal Brief filed on December 8, 2010. Withdrawal of this rejection is respectfully requested.

5. Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby, Dlugos and Markl (US 5,710,706).

Applicants respectfully submit that, for at least the following reasons, the combined teachings of Baum, Boothby, Dlugos, and Markl do not disclose all of the features of the claimed combination of independent claim 1, in which "a franking machine [ ] franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date."

The present invention allows the user to decide whether to use a new (updated) tariff or to use the current tariff even though it is out of date.

Specifically, independent claim 1 recites, *inter alia*, "the device further comprising a franking machine which franks the mail item with the current postal data when it has determined

that the current postal data has not changed, even though the date of the application of the current postal data is out of date."

The Examiner concedes that Baum in view of Boothby and Dlugos does not disclose this feature of claim 1. Accordingly, the Examiner cites to Markl, and specifically column 1, lines 2-34 and column 4, line 57-column 5, line 3 of Markl, as allegedly teaching this feature to make up for the deficiencies of Baum, Boothby and Dlugos.

The Examiner's position appears to be similar to the Officially Noticed position asserted by the Examiner in reference to claim 5. Accordingly, the rejection to claim 1 suffers from the same deficiencies mentioned above with respect to claim 5.

In addition, column 4, line 57-column 5, line 3 of Markl describes that new postal rate tables are installed early and are accessible to all customers before the change of the rates officially takes place. By informing each user early of which portion of the table is going to change, the user can implement the change when the new rates become valid. In other words, the user is given the new rate table ahead of time so that when the new rate takes effect on the specified date, the new rates can be used instead of the old rates.

However, no portion of this new rate table is used prior to the effective date and once that effective date is past, the new rate *replaces* the old rate. That is, the old rate is no longer used. For example, column 4, lines 27-28 of Markl states that the postal rate table is updated "at the right time," and column 4, line 58, refers to the invention allowing for "early preparation" of the new postal rate tables that are to be used. Thus, Markl only franks items with the old table prior to the effective date and only franks items with the new table after the effective date.

Accordingly, Applicant maintains that the combined teachings of Baum. Boothby, Dlugos, and Markl fail to disclose or suggest "a franking machine which franks the mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date," as recited in claim 1.

Therefore, Claims 2 and 3 are allowable because of their dependency from Claim 1.

6. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum in view of Boothby, Dlugos and Markl and further in view of Thiel (US 6,321,214).

Claim 4 is allowable because Thiel fails to remedy the deficiencies of Baum, Boothby, Dlugos and Markl in that Thiel does not disclose franking a mail item with the current postal data when it has determined that the current postal data has not changed, even though the date of the application of the current postal data is out of date. Nor does not Thiel disclose or suggest comparing the postal data one-by-one.

7. Claims 5-7 and 9-10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Baum et al. (US 7,103,583; hereinafter "Baum") in view of Boothby (US 5,684,990) and Dlugos et al. (US 6,463,133; hereinafter "Dlugos"), and further in view of Official Notice.

Applicants respectfully submit that, for at least the following reasons, the combined teachings of Baum, Boothby, Dlugos, and the Official Notice do not disclose all of the features of the claimed combination of independent claim 5, in which the mail item is franked with current postal data even though the date of application of the current postal data is out of date.

Independent claim 5 recites features that are similar to claim 1. Specifically, Claim 5 recites, among other features, "when it has been determined that the current postal data has not changed, franking the mail item with the current postal data using a franking machine even though the date of application of the current postal data is out of date."

Accordingly, insofar as claim 5 is similar to claim 1, claim 5 is patentable over the cited references for at least the same reasons discussed, *supra*, relating to independent claim 1.

Therefore, Claims 6, 7, 9, and 10 are allowable because of their dependency from Claim 5.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal.

An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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